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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,679	03/17/2004	Tomotsune Nishimura	NEC08452US	3334
21254 7590 01/09/2009 MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC 8321 OLD COURTHOUSE ROAD SUITE 200 VIENNA, VA 22182-3817				
EXAMINER JAKOVAC, RYAN J				
ART UNIT 2445		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/801,679

Applicant(s)

NISHIMURA, TOMOTSUNE

Examiner

RYAN J. JAKOVAC

Art Unit

2445

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-8, 10-16 and 18-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-8, 10-16 and 18-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date 10/30/2008
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed 10/30/2008 has been entered.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Claim 1 recites the term "replaying" in regards to automatically replaying a return email. The term replaying is absent from the specification, and therefore fails to provide proper antecedent basis for the claimed subject matter as recited in claim 1.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter such as “replaying a return email” which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 recites the limitation “replaying a return email.” The term “replaying” or “replaying a return email” is not disclosed in the specification. Therefore one of ordinary skill in the art at the time of invention would not be apprised as to the functional steps and/or elements are involved in replaying or automatically replaying an email.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 7 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recites “said judging being carried out prior to said checking” however the claim language “checking” as described in claims 6 and 20 respectively, which claims 7 and 21 depend upon, is used in two separate limitations. This therefore renders the scope of the claims indefinite.

8. Claim 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim recites “associating the message from the third memory area with the

automatic reply if the first memory area found the address of the received email." It is unclear how a memory is capable of finding and address of an email.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 3-8, 10-16, 18, and 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Running Microsoft Outlook 97" (hereinafter Outlook) in view of US 2002/0091777 to Schwartz.

Regarding claim 1, 11, 20, 23, the combination of Outlook and Schwartz teaches a method of automatically replying to a received e-mail in a mobile terminal having a function of transmitting and receiving an e-mail, the method comprising:

determining whether to automatically reply to the received e-mail (Outlook, pg. 38-43, rules are setup to automatically reply to an email.);

determining whether the received e-mail originates from a known address (Outlook, pg. 39-40, Inbox Assistant acts (i.e. rules are applied to) items from a particular sender (i.e. a known address).);

determining whether text data is associated with the known address (Outlook, pg. 40, specified text in the message body is identified.);

determining whether image data is associated with the known address (Outlook, pg. 39-41, attachment files are identified for messages associated with a specified sender (i.e. a known address).);

editing the image data in accordance with the known address (Outlook, pg. 104-107, images are inserted into a message. Pg. 43-44, messages are saved as templates to be included in automatic replies. See also, Schwartz, [0023], image data which is to be associated with a reply message to a specific sender "may be converted to different file formats, resolutions, sizes, etc."); and

automatically transmitting the image data determined in accordance with the known address of said received e-mail to said address if the method determines to automatically reply to the received e-mail (Outlook, pg. 38-43, 104-107, message templates are selected to be used in automatic replies. Messages include image attachments. See also, [0020-0023] of Schwartz which disclose a user selecting replies to be used as an automatic response which include text, audio, graphics, video, facsimile image, or any combination thereof, or other suitable information type.),

wherein when an automatic reply is permitted and the received email includes the known address and the return email is known (Outlook, pg. 38-45, an automatic reply is sent to a

specific sender based on a saved message template.), automatically replaying a return email including the image data, and if no image data is stored, a return email not having image data is replayed automatically (Outlook, pg. 38-45, automatic replies are sent based on the stored template associated with a specific sender.).

Outlook in pgs. 38-45 discloses automatically replying to an email from a specific sender based. The "Reply With" option allows a template message to be used in the automatic reply. A message may be saved as a template to be included with an automatic reply. According to Outlook, pg. 104-107, messages may include images. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include images in a message template to be used in an automatic reply to an email since including images would be an obvious variation of a message as disclosed by Outlook. Further, it would be obvious to combine the teachings of Schwartz and Outlook since both disclose known methods of generating automatic replies to emails. In particular, it would have been obvious to one of ordinary skill in the art at the time of invention to use a mobile terminal such as personal digital assistant or a telephone as described in paragraphs [0020-0021] of Schwartz since these are obvious variations of a terminal used to send and receive email messages.

Regarding claim 3, the combination of Outlook and Schwartz teaches the method as set forth in claim 1, wherein said image data comprises moving-image data (Schwartz, Paragraph [0021-0022], stored replies may be text, audio, graphics, video, facsimile image, or any combination thereof. See also, [0015].).

Regarding claim 4, 5, the combination of Outlook and Schwartz teaches the method as set forth in claim 1, wherein text data determined in accordance with said known address is automatically transmitted together with said image data (Outlook, pg. 43-45, automatic replies are sent based on template messages.).

Regarding claim 6, the combination of Outlook and Schwartz teaches a method of automatically replying to a received e-mail in a mobile terminal having a function of transmitting and receiving an e-mail, comprising: checking whether an address of a transmitter of a received e-mail is stored in a memory (Outlook, pg. 39-40, Inbox Assistant acts (i.e. rules are applied to) items from a particular sender (i.e. a known address).); checking whether image data associated with said address is stored in said memory (Outlook, pg. 39-41, attachment files are identified for messages associated with a specified sender (i.e. a known address).); editing said image data in accordance with said address (Outlook, pg. 104-107, images are inserted into a message. Pg. 43-44, messages are saved as templates to be included in automatic replies. See also, Schwartz, [0020-0023].); and transmitting said image data to said address (Outlook, pg. 43-45, automatic replies are sent based on template messages assigned to senders.).

Regarding claim 7, 21, the combination of Outlook and Schwartz teaches the method as set forth in claim 6, further comprising judging whether it is determined to automatically transmit image data determined in accordance with said address, to said transmitter (Schwartz, Paragraph [0028], teaches “determine what, if any, reply message or messages and attached files should be generated and the corresponding address or addresses where the reply messages and

reply files should be sent.), said judging being carried out prior to said checking (Schwartz, In Paragraph [0028] the phrase "if any" shows that the determination of whether or not an automatically generated reply message would be sent or not is determined before it searches the storage. If the determination was made after it searched, there would be no need for Schwartz to give the scenario where the electronic message or address didn't exist in the storage.).

Regarding claim 8, 22, the combination of Outlook and Schwartz teaches the method as set forth in claim 6, further comprising checking whether text data associated with said address is stored in said memory, wherein said text data is transmitted to said address together with said image data in said transmitting (Outlook, pg. 43-45, automatic replies are sent based on template messages assigned to senders.).

Regarding claim 10, the combination of Outlook and Schwartz teaches the method as set forth in claim 6, wherein said image data comprises moving-image data (Schwartz, Paragraph [0021-0022], stored replies may be text, audio, graphics, video, facsimile image, or any combination thereof. See also [0015].).

Regarding claim 12, 14, the combination of Outlook and Schwartz teaches the mobile terminal as set forth in claim 11, wherein said controller edits said image data in accordance with said address (Outlook, pg. 104-107, images are inserted into a message. Pg. 43-44, messages are saved as templates to be included in automatic replies.).

Regarding claim 13, the combination of Outlook and Schwartz teaches the mobile terminal as set forth in claim 11, wherein said image data comprises moving-image data (Schwartz, Paragraph [0021-0022], stored replies may be text, audio, graphics, video, facsimile image, or any combination thereof. See also, [0015].).

Regarding claim 15, the combination of Outlook and Schwartz teaches the mobile terminal as set forth in claim 11, wherein said mobile terminal comprises of a cellular phone (Schwartz, Paragraph [0003] teaches "an electronic message, whether it is a text based e-mail, a facsimile image, a video, or a voice message, is generated by a user at a computer or other suitable wired or wireless electronic device such as, for example, a personal digital assistant, a telephone, a charge coupled device (CCD), or a facsimile machine.").

Regarding claim 16, the combination of Outlook and Schwartz teaches the mobile terminal as set forth in claim 11, wherein said controller comprises a data processor; a first memory area for storing addresses to which an e-mail is automatically transmitted (Outlook, pg. 40, fig. 2-2, message rule comprises a message field indicating where the auto reply will be transmitted.), a second memory area for storing moving-data to be edited by a user of said mobile terminal for each of said addresses (Schwartz, Paragraph [0029] teaches "The method further includes storing 23 a reply file to be sent to the sender, preferably, but not necessarily, by attachment to the message reply." Paragraph [0015] teaches "In keeping with the invention, the reply files may comprise any suitable file including, without limitation, a text file (e.g. Microsoft Word, Corel Wordperfect, etc.), a still image (e.g. JPEG, GIF, TIFF, PICT, EPS, PDF, PNG,

DCF, DPOF, FLASHPIX, etc.) an audio clip (e.g. MPEG, MPEG II, MPEG III, MPEG IV etc.), a video clip, an Internet link, etc.". See also, pg. 44 of Outlook disclosing message templates.), a first retriever which retrieves said addresses stored in said first memory area, a second retriever which retrieves said moving-data stored in said second memory area, a third memory area for storing a message to be edited by said user (Schwartz, Paragraph [0028] teaches generating a message according to the stored addresses and files. Generating the message inherently includes fetching the stored information.); and a third retriever which retrieves said message stored in said third memory area (Schwartz, Paragraph [0029] teaches "The automated method for generating a reply message and/or reply file to a sender includes storing 22 a reply message to a message sent having a selected recipient address and at least one sender address." Storing a reply message to a sender address inherently includes storing the sender address. Additionally the stored message can be edited by adding a file to the message. See also, Outlook, pg. 38-45, automatic replies are generated based on the information in stored message areas such as the sender, the reply with category indicating the stored message templates, and other stored rule properties.).

Regarding claim 18, the combination of Outlook and Schwartz teaches the mobile terminal as set forth in claim 11, wherein said controller comprises a unit for determining whether said image data is automatically transmitted in response to said received e-mail (Schwartz, Paragraph [0028] teaches "On receipt of the message at the message server 16, the message server or other electronic equipment in communication therewith, will associate the message with a specific recipient and cross reference the recipient's user profile, and in particular, both the user's reply message profile and reply file profile, to determine what, if any,

reply message or messages and attached files should be generated and the corresponding address or addresses where the reply messages and reply files should be sent.").

Regarding claim 24, the combination of Outlook and Schwartz teaches the mobile terminal as set forth in claim 16, wherein said controller receives the received email from an associated external server (Outlook, pg. 44, automatic replies.), determines the automatic reply to the received email according to whether an address of the received email is stored within the first memory area (Outlook, pg. 40, rules associate automatic replies with a specific sender.), associating the moving data (Schwartz, [0015].) from the second memory area with the automatic reply if the first memory area found the address of the received email (Outlook, pg. 40, rules associate automatic replies with a specific sender.), and associating the message from the third memory area with the automatic reply if the first memory area found the address of the received email, and sending the automatic reply to the associated external server (Outlook, pg. 43-45, automatic replies are sent based on template messages.).

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by US 2002/0091777 to Schwartz.

Regarding claim 19, Schwartz teaches a computer readable medium comprising a program for causing a computer to carry out a method of automatically replying to a received e-mail (Schwartz, Paragraph [0001], method and system for automatically generating a message reply and file.) in a mobile terminal comprising a function of transmitting and receiving an e-mail (Schwartz, Paragraph [0003] teaches "an electronic message, whether it is a text based e-mail, a facsimile image, a video, or a voice message, is generated by a user at a computer or other suitable wired or wireless electronic device such as, for example, a personal digital assistant, a telephone, a charge coupled device (CCD), or a facsimile machine."), wherein steps executed by said computer in accordance with said program include automatically transmitting image data determined in accordance with an address of a transmitter of said received e-mail, to said address (Schwartz, Paragraph [0014] teaches "reply messages and reply files are stored at an associated message server or a database or other peripheral in communication therewith. The recipient may generate or have generated for her a standard reply message and reply file to be sent to all electronic message senders, may select from one or more standard reply messages and files, or may generate sender-specific reply messages and files". See also [0019-0022], a user selects replies to be used as an automatic response according to a specific sender which include text, audio, graphics, video, facsimile image, or any combination thereof, or other suitable information type..).

Response to Arguments

12. Applicant's arguments with respect to claims 1, 3-8, 10-16, 18-24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 5,555,346 to Gross et al. US 2003/0065779 to Malik et al. US 2004/0092250 to Valloppillil.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RYAN J. JAKOVAC whose telephone number is (571)270-5003. The examiner can normally be reached on Monday through Friday, 7:30 am to 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton B. Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/RJ/

/Larry D Donaghue/

Primary Examiner, Art Unit 2454